

REMARKS

Claims 25 - 33 remain in this application, claims 1 - 24 having been canceled without prejudice or disclaimer.

Claims 25 and 30 have been amended in order to more particularly point out, and distinctly claim the subject matter to which the applicants regard as their invention. It is believed that this Response is fully responsive to the Office Action dated August 24, 2005.

In the outstanding Action, the Examiner again relies on Girardello (of record) in rejecting claims 25, 26, 28 and 29 under 35 USC 103 based on Girardello, and in rejecting claims 27 and 30 - 33 under 35 USC 103 based on Girardello in view of Japanese Patent Publication No. 1-272719 (also of record).

The applicants respectfully request reconsideration of these rejections.

It is noted that the Examiner's outstanding Action is in response to the applicants' Preliminary Amendment filed May 31, 2005.

Summarily, in the applicants' May 31, 2005 Preliminary Amendment, the applicants took the position that their claimed core region includes a soft layer located between the inner and outer circumferential surfaces. More importantly, the claimed soft layer is: (1) attached to the inner and outer circumferential surfaces, and (2) is composed of either:

- (a) a structure consisting of pearlite and bainite or
- (b) at least two structures selected from the group consisting of ferrite, pearlite, bainite and martensite.

In the outstanding Office Action (specifically, in the "Response to Arguments" portion, page 4 thereof, consisting of four (4) paragraphs, the second through fourth paragraphs being the pertinent portions), the Examiner now takes the following positions:

(1) the claim limitation for item (b), above, allows for at least two structures such as ferrite, pearlite, bainite, and martensite; thus, the previous amendment on item (a), above, does not affect item (b);

(2) the use of "soft layer" is relative; martensite is a hard material; and "[t]herefore, soft layer reads on a core;" and

(3) lines 7 - 17, page 15 of the applicants' specification describe the "soft layer" to be positioned closer to the inner circumferential surface.

First, with respect to the Examiner's position in item (1), above, the applicants have deleted "ferrite" from the limitation designated as item (b) from each of claims 25 and 30.

Second, with respect to the Examiner's position in item (2), above, with due respect to the Examiner, the applicants respectfully submit that the Examiner's position is not relevant because what is significant are the facts that in the applicants' claimed invention, the claimed soft layer is attached to the inner and outer circumferential surfaces and there is no situation in which the claimed soft layer is composed of a single structure.

Third, if, as argued by the Examiner, the term "soft" is relative, then clearly the phrase "closer to the inner circumferential surface" is similarly relative. In any event, based on the applicants' comments immediately above (in response to the Examiner's second argument), the Examiner's third argument is similarly not relevant.

It is clear that with the amendments to claims 25 and 30, at least two structures selected from the group consisting of pearlite, bainite and martensite is provided for in the applicants' claimed soft layer; whereas, Girardello's structure, if *arguendo* the Examiner's position is applied, may be provided from the selection of martensite, sorbite and ferrite. As such, the limitations now set forth in claims 25 and 30 for, for example, the applicants' claimed soft layer are not met by the teachings of Girardello.

The secondary reference (i.e., the Japanese Patent Publication) is merely relied upon for teaching a “bushing steel composition.” However, such teaching in this secondary reference does not supplement the above-discussed deficiencies in the teachings of Girardello in failing to fully meet the applicants’ claimed invention, as now set forth in independent claims 25 and 30, and the claims that respectively depend therefrom.

Accordingly, a person of ordinary skill in the art would not have found the applicants’ claimed invention, as now set forth in independent claims 25 and 30 and the claims that respectively depend therefrom, obvious under 35 USC 103(a) based on the teachings of the cited prior art.

As such, the withdrawal of the outstanding obviousness rejections under 35 USC 103(a) based on Girardello, singly or in combination with the Japanese Patent Publication No. 1-272719, is in order, and is therefore respectfully solicited.

The above amendments are believed to place the claims in proper condition for examination. Early and favorable action is awaited.

Response under 37 C.F.R. §1.116 filed January 12, 2006
U.S. Patent Application Serial No. 09/884,998

In the event that any fees are due in connection with this paper, please charge our Deposit
Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, KRATZ, QUINTOS,
HANSON & BROOKS, LLP

A handwritten signature in black ink, appearing to read 'Mel R. Quintos', with a stylized flourish at the end.

Mel R. Quintos
Attorney for Applicants
Reg. No. 31,898

MRQ/lr/ipc

Atty. Docket No. **980923A**
Suite 1000
1725 K Street, N.W.
Washington, D.C. 20006
(202) 659-2930



23850

PATENT TRADEMARK OFFICE